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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,919	10/03/2000	Warren Alan Montgomery	LUC-170/Mon*9	5970

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EXAMINER	
ESCALANTE, OVIDIO	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/677,919	Applicant(s) MONTGOMERY ET AL.	
	Examiner Ovidio Escalante	Art Unit 2645	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Advisory Action Attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
Primary Examiner
Art Unit: 2645

Advisory Action

1. Applicant contends the Examiner's interpretation of the PBX disclosed in Chan as an Intelligent Network Node based on the Examiner's interpretation in that since it is in a network and has the intelligence to determine offending time slots and to filter out music then it is an Intelligent Network Node. The Applicant's arguments are based in view of the specification which describes the Intelligent Network Node of the claims as having both bearer and signing connections to the switches of the telephone network and wherein the Intelligent Network Node is an SCP (Service Control Point) or a service node. The Examiner respectfully disagrees with Applicant's arguments for the reasons set forth below.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the Intelligent Network Node having both bearer and signaling connects to the switches of the telephone network and the Intelligent Network Node being a SCP or SN) are not recited in the rejected independent claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

While the Examiner agrees that the Applicant's specification includes the teaching of an Intelligent Network Node being a SCP or SN which includes bearer and signaling connections to the switch the Examiner believes that the independent claims cannot be narrowed to this limitation since the Applicant and one of ordinary skill in the art may interpret the independent claims broader. The Examiner believes that Intelligent Network Node is broader that what the specification states since the Applicant further limits the Intelligent Network Node in dependent

claims to be a Service Control Point or a Service Node. Therefore, since dependent claims further limit the independent claims then clearly Intelligent Network Node cannot be read to include the limitations as outline by the Applicant in the specification.

Furthermore, as recited in the dependent claims the Examiner believes that it would have been obvious to one of ordinary skill in the art to modify the primary reference to include SCP or service nodes for the reasons set forth in the Final Office Action.

2. Applicants contend that regarding the Examiner's contention that Chan et al. discloses an alternative method in which music is filtered from the subject time slot, it is well-settled that the disclosure in an anticipated reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient. The Examiner respectfully disagrees.

When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be enabled. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). Since Applicant has not successfully proved non-enablement by the prior art, then the prior art is presumed to be enabled.

Prior art is prior art **for all they contain** "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred

embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

The Examiner believes that the filtering method described in col. 7 lines 18-20 which states "Music suppression can be performed by filtering out the music energy from the subject time slot while leaving the time slot as part of the list of active time slots." is all that would have been needed to reasonable suggest to one having ordinary skill in the art to anticipate the use of filtering music energy. Since filtering is disclosed by the prior art as being an alternative embodiment to the same method process then the Examiner maintains that the prior art clearly anticipates the claims.